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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,413	01/22/2004	Ian Peek	2810	4528
7590	02/07/2006		EXAMINER	
STRIKER, STRIKER & STENBY 103 East Neck Road Huntington, NY 11743				LEGESSE, NINI F
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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/762,413

MAILED

Filing Date: January 22, 2004

FEB 07 2006

Appellant(s): PEEK, IAN

Group 3700

Peek Ian
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/22/04 appealing from the Office action mailed 04/12/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US Patent No. 3,768,501 to Elson et al.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Elson (US Patent No. 3,768,501).

Elson discloses an upright rack made of a rigid material (33) and an inflatable element (10) is provided on said upright rack aligned substantially horizontally and parallel to a desired hitting direction (see Fig. 1). However, the inflatable balloon element 10 fails to be in a rod shape. It is known that balloons come in different shapes including cylindrical shaped balloons that could be considered as a rod. With respect to the intended use of the claim, that the device is to be used as a golf training apparatus, it should be noted that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations and the Elson's device is obviously capable of being used as a training apparatus (see MPEP 2111 and 2112).

(10) Response to Argument

Appellant argues that the Elson's reference is a non-analogous art. Examiner clearly understands that the main invention in Elson is the valve. However, the reference teaches the use of a tank 33 along with the valve and the use of a balloon (10) along with the tank and the valve. With regards to the non-analogous argument, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir.

1992). In this case, the examiner is giving the broadest reasonable interpretation of the claim as set forth in MPEP 904.01(a). The examiner notes that apparatus claims must be structurally distinguishable ^{from} ~~form~~ the prior art. See MPEP 2114. Examiner maintains that all the structural limitations are met with Elson. Therefore, examiner deems that the rejection is proper.

Appellant argues that the Elson device cannot be considered as an upright rack or an upright element. Examiner respectfully disagree because the tank (33) as shown on Fig. 1 is clearly upright and the tank clearly given the broadest interpretation of the word "rack" Elton's tank could be considered as a rack.

In response to applicant's argument that the Elson device could not be used as golf training apparatus, please note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the preamble of the claim is stating the intended use of the device and the structure being claimed is just a rack with an inflatable rod. As stated supra, apparatus claims need to distinguish over the prior art with structure and not function or intended use. Even though the device is not disclosed to be used as a golf-training device, it is capable of use as claimed (see MPEP 2111 and 2112).

Appellant argues that the balloon element of the Elson reference cannot be compared with the claimed inflatable rod. Please note that balloons come in different shapes and sizes. For example, the long rod shaped balloons that clowns use for kids

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birthday parties to create ~~swords~~, cars, and flowers and the likes could be used along the Elson device. Even though the Elson device is silent about the shape of the balloon, the reference discloses that the device is used to inflate balloons. The use of a rod like balloon is clearly obvious.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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PRIMARY EXAMINER

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